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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/038,187	01/04/2002	Alan B. Collison	5094-000001	8383
27572	7590	03/22/2004	EXAMINER	
HARNESS, DICKEY & PIERCE, P.L.C. P.O. BOX 828 BLOOMFIELD HILLS, MI 48303			YAO, SAMCHUAN CUA	
			ART UNIT	PAPER NUMBER
			1733	

DATE MAILED: 03/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

AS

Office Action Summary	Application No. 10/038,187	Applicant(s) COLLISON ET AL.	
	Examiner Sam Chuan C. Yao	Art Unit 1733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 January 2002.
 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
 4a) Of the above claim(s) 9-17 is/are withdrawn from consideration.
 5) ☐ Claim(s) _____ is/are allowed.
 6) ☒ Claim(s) 1-8 and 18-20 is/are rejected.
 7) ☐ Claim(s) _____ is/are objected to.
 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>01-02-02, 02-05-04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-8 and 18-20, drawn to an insulative textile flooring pad, classified in class 442, subclass 324.
 - II. Claims 9-17, drawn to a floor structure, classified in class 428, subclass 221.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because, the combination does not require using the recited materials for binding fibers (claim 1) **or** amount of binder fibers (claim 18) and a pad density of greater than 10 pcf. The subcombination has separate utility such as such as using the recited pad or underlayment as an insulating backing for a structural wall or a padding for an auto interior roofing.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Art Unit: 1733

4. This application contains claims directed to the following patentably distinct species of the claimed invention:

Species A: surface material is a wood;

Species B: surface material is a ceramic.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 9 is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over

the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

5. During a telephone conversation with Mr. Keller on 03-10-04 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-8 and 18-20. Affirmation of this election must be made by applicant in replying to this Office action. Claims 9-17 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1, 3-4, 8, and 18-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Kato (US 4,908,176).

Kato discloses a moldable non-woven fabric for a house flooring, the non-woven fabric comprises 50-85 wt% of synthetic fibers such as a polyethylene terephthalate, polyamide and/or natural fibers such as a cotton (taken to be

Art Unit: 1733

reinforcing fibers) and 15-85 wt% thermoplastic binder fibers such as a polypropylene, wherein the fabric has a density range of 0.15-0.5 g/cc (i.e. 9.36-31.31 pcf) (preferably, 0.17-0.3 g/cc; 10.61-18.7 pcf) (col. 2 line 63 to col. 3 line 31; col. 4 lines 1-41; claims 1-5).

Although Kato does not explicitly describe a resultant non-woven fabric as an insulative textile flooring pad or a flooring underlayment, this limitation is taken to read on the non-woven fabric, because the fabric of Kato is not only capable of being used the intended application in claim 1 or 18, but also bonded a resultant to a surface sheet such as ply-wood, carpet, decorative paper, etc. (col. 4 lines 23-42).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 2 and 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kato (US 4,908,176) as applied to claim 1 or 4 above.

Kato teaches a) using as low as 15 wt% of thermoplastic binder fibers (col. 3 lines 8-14; claim 1); b) fully mixing fibers in a non-woven fabric (col. 2 lines 63-67); c) fiber size of 1.2-300 denier and fiber length of 2.5-150 mm (i.e. 0.1-5.9 inches; col. 2 lines 63-66); and, d) *"superposing cards made of fibers on each*

other in such an amount that the desired web weight per unit area is attained"

(col. 2 line 67 to col. 3 line 2).

As for claim 2, it is a common practice in the art to fully blend fibers in a nonwoven fabric by randomly air-laying various fibers components in a nonwoven fabric, for this reason, the limitation in this claim would have been obvious in the art.

With respect to claims 5-7, although not presently recited, it would have been obvious in the art to use reinforcing fibers and binder fibers having a length range of 0.1-1.5 inches and a denier range of 5-12 (fiber dimensional range taught in the present invention, paragraph number 0017), because one in the art would have chosen, by routine experimentation, a workable range taught by Kato noted above. It directly follows that, since it is obvious in the art to uniformly and randomly distribute fibers in a fabric taught by Kato, since the fiber dimensional ranges (specification paragraph number 0017) taught in the present invention is obvious in the art; and since Kato teaches using as low as about 15 wt% of thermoplastic binder fibers (this amount is identical to claim 4); and using as high as 85 wt% of synthetic (PET) or natural (cotton) fibers; the insulating pad/underlayment of the present invention is structurally indistinguishable from a resultant nonwoven fabric taught by Kato. For this reason, the limitations in these claims are expected to naturally flow from the non-woven fabric taught by Kato et al.

Note further: Where ... the claimed and prior art products are identical or substantially identical, or are produced by identical or substantially identical

Art Unit: 1733

processes, the PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his claimed product. **Whether the rejection is based on "inherency" under 35 USC § 102, on prima facie obviousness" under 35 USC § 103, jointly or alternatively, the burden of proof is the same, and its fairness is evidenced by the PTO's inability to manufacture products or to obtain and compare prior art products."** In re Best, 562 F2d 1252, 1255, 195 USPQ 430, 433-4 (CCPA 1977).

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sam Chuan C. Yao whose telephone number is (571) 272-1224. The examiner can normally be reached on Monday-Friday with second Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on (571) 272-1226. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1733

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Sam Chuan C. Yao
Primary Examiner
Art Unit 1733

Scy
03-14-04